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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,926	01/31/2001	Kenichi Ishiguri	202678US2	9947
22850	7590	12/21/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				PHAM, THOMAS K
ART UNIT		PAPER NUMBER		
2121				

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/772,926	ISHIGURI, KENICHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas K Pham	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 September 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

1. This action is in response to request for re-consideration filed on 09/27/2004.
2. New claim 6 filed by the applicant has been entered.
3. Claims 1-4 have been considered but they are not persuasive.
4. Applicant's amendment, with respect to the addition of claim 6 and the new issue of claim 5, necessitated the new ground(s) of rejection presented in this Office action.

**Quotations of U.S. Code Title 35**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim Rejections - 35 USC § 103**

7. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 11-074930 ("Sadao") in view of Japanese Patent No. 11-032196 ("Masafumi").

**Regarding claim 1**

Sadao teaches an e-mail communication terminal apparatus to be connected to an e-mail system comprising: division control means for dividing transmission data into divisional data (page 2, paragraph 7); transmitting means for transmitting the divisional data produced by said division control means (page 2, paragraph 8); receiving means for receiving data (page 4, paragraph 24); and recombination control means for recombining the data received by said receiving means when the data are divisional data that were separated from each other by a transmission source (page 4, paragraph 24). Sadao does not teach an e-mail system that is limited in an amount of data that can be communicated at one time, and dividing the data based on a predetermined data amount when the transmission data has an amount larger than the communicable data amount of the e-mail system. However, Masafumi teaches an e-mail system that is limited in an amount of data that can be communicated at one time (page 2 paragraph 7), and dividing the data based on a predetermined data amount when the transmission data has an amount larger than the communicable data amount of the e-mail system (page 3, paragraphs 10 and 11) for the purpose of transmitting large electronic mails to a network that only accepts small electronic mails. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a email size determination system of Masafumi with the email communication terminal of Sadao because it would provide for the purpose of transmitting large

electronic mails to a network that only accepts small electronic mails.

**Regarding claim 2**

Sadao teaches information adding means for adding division information to the divisional data produced by said division control means, wherein the recombination control means recombines, based on division information, received divisional data to which the division information is added (page 4, paragraph 25).

**Regarding claim 3**

Sadao teaches the division information includes information indicating that the transmission data is divisional mail (page 4, paragraph 26).

**Regarding claim 4**

Sadao teaches the division information includes information indicating recombination order (page 4, paragraph 26).

**Regarding claim 6**

Sadao teaches an e-mail communication terminal apparatus to be connected to an e-mail system that is limited in an amount of data that can be communicated at one time, comprising: a division controller configured to divide transmission data into divisional data (page 2, paragraph 7); a transmitter configured to transmit the divisional data produced by said division controller (page 2, paragraph 8); a receiver configured to receive data (page 4, paragraph 24); and recombination controller configured to recombine the data received by said receiver when the data are divisional data that were separated from each other by a transmission source (page 4, paragraph 24). Sadao does not teach an e-mail system dividing the data based on a predetermined data amount when the transmission data has an amount larger than the communicable data amount of

the e-mail system. However, Masafumi teaches an e-mail system that is limited in an amount of data that can be communicated at one time (page 2 paragraph 7) by dividing the data based on a predetermined data amount when the transmission data has an amount larger than the communicable data amount of the e-mail system (page 3, paragraphs 10 and 11) for the purpose of transmitting large electronic mails to a network that only accepts small electronic mails. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a email size determination system of Masafumi with the email communication terminal of Sadao because it would provide for the purpose of transmitting large electronic mails to a network that only accepts small electronic mails.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 11-205458 (“Yashihiro”).

**Regarding claim 5**

Yashihiro teaches an e-mail communication terminal apparatus to be connected, by radio, to an e-mail system that is limited in an amount of data that can be communicated at one time (abstract), comprising: division control means for dividing transmission data into divisional data based on a predetermined data amount when the transmission data has an amount larger than the communicable data amount of the e-mail system (page 3, paragraph 13), and radio transmitting means for transmitting the divisional data produced by said division control means (page 3, paragraph 15). Yashihiro does not teach the transmission control means for adding a header with an information to the divisional data. “Official Notice” is taken for the concept and advantages of adding a header with information to the divisional data of an email is well known

and expected in the art. U.S. Patent No. 5,812,669 by Jenkins et al. teaches transmitting secure EDI over the Internet using email messages by packaging the partials of the message (MIME-partial) with body parts together with a new header (see col. 15 TABLE A sections: "MIME packaging" and "MIME unpackaging" and specifically col. 15 lines 39-44) for the purpose of transmits and receives data securely over an open network. More support about EDI transaction using email can be found in Ratnasingham, Pauline "Information Management & Computer Security" and Debenham, M. J. "Communications support for EDI" included a copy herein. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add a header information to the divisional data of an email message for the purpose of easily transmits and receives data securely over an open network.

### *Response to Arguments*

9. Applicant's arguments with respect to claim 5 have been considered but are moot in view of the new ground(s) of rejection.

*In the remark the applicant argues that cited reference fails to disclose:* "limited in an amount of data that can be communicated" as to claim 1.

*In response to applicant's argument,* the recitation "limited in an amount of data that can be communicated" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural

limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (571) 272-3689, Monday - Thursday from 6:30 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (571) 272-3687.

Any response to this office action should be mailed to: **Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450**. Responses may also be faxed to the **official fax number (703) 872- 9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Thomas Pham**  
*Patent Examiner*

*TP*

December 15, 2004

*Anthony Knight*  
**Supervisory Patent Examiner**  
Group 3600